

Ce



14
6
UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/920,044 05/07/99 SEMPLE

W 4539/003C

EXAMINER

TM02/0821

CURTIS A. VOCK
LATHROP & GAGE
4845 PEARL EAST CIRCLE
SUITE 302
BOULDER CO 80301

ALAM, H	
ART UNIT	PAPER NUMBER

2172
DATE MAILED:

14
16
08/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1 FIVE COPY
GG

Office Action Summary

Application No.

08/920,044

Applicant(s)

SEMPLE ET AL.

Examiner

Hosain T Alam

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 482.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the amendment received by the Office on July 3, 2001. Claims 38-74 are pending in this Action.

Information Disclosure Statement

The references in the information disclosure statement filed by the applicant and received by the Office on March 5, 2001, Paper No. 12, have been considered.

The information disclosure statement (IDS) filed by the applicant and received by the Office on February 12, 2001, Paper No. 9, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The references have not been provided.

The IDS received on February 12, 2001, contains a mountain of material including approximately 244 U. S. patents, 64 published patent applications, and 290 non-patent references. The number of references is unusually high.

Since the applicants have filed the IDS, it can be reasonable inferred that they are more likely to know which of the 598 references are relevant to the claimed invention. If the applicants have filed the IDS without knowing the relevance of references to the claims, then it would be reasonable to explore the necessity of such filing.

Art Unit: 2172

Even when copies of the 598 referenced are made available to the Office, it will take significant amount of time to review each of them.

An applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "a mountain of largely irrelevant [material] from which he is *presumed* to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work." *Rohm & Haas Co. v. Crystal Chemical Co.*, 722 F.2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (Emphasis in original).

The references in the IDS filed by the applicant and received by the Office on February 12, 2001, have not been considered.

Claims 38-45, 47-50, 53-55, 59-63, and 70-72, as amended, are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application EP 0508787A2 published on October 14, 1992, hereinafter to be known as "Nobe."

The rejection set forth in the previous Office Action is hereby incorporated by reference.

Claims 46, 51-52, 56-58, 64-69, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobe.

The rejection set forth in the previous Office Action is hereby incorporated by reference.

As to claim 46, it would have been obvious to utilize a communication link similar to the one used in TV, fax, speaker, or display because the system of Nobe (as shown in Fig.

1) is compatible with each of them and their addition would have enhanced the versatility of the system.

Claims 68-69, as amended, are rejected under the same rationale given to claim 46 hereinabove.

Response to Arguments

Applicant's arguments filed in the amendment have been fully considered but they are not persuasive. The reasons are set forth hereinbelow.

Applicants argue:

(1) "Nobe does not permit selection of a category associated with the items of interest; rather every item is a service facility". Page 11.

(2) "Nobe does not describe a database - but only memory means", page 12, lines 2-3.

(3) "Nobe does not permit specifying a location that is not the same as the vehicle location." Page 12, lines 5-6.

In the above arguments, applicants' mischaracterize the Nobe reference.

As to (1): Nobe, in the **abstract**, indicates that service facilities are restaurants, hotels, or the like. Therefore, the applicants' characterization that Nobe select only one category has no proper basis.

As to (2): The issue is not whether Nobe uses memory means, but what Nobe stores the memory means. Nobe, in col. 1, lines 5-9, indicated what can be stored in the memory means. Further, Nobe teaches the use of external database, volatile and non-volatile memory to store data. See col. 3, lines 47-51. Nobe teaches the step of storing

data in an on-board memory means as well as an external storage. Therefore, Nobe teaches database as claimed.

As to (3): Applicants rely on a limitation that cannot be found in the claims. It appears that the applicants are referring to the step of "specifying (the) geo-defined location..." however, the examiner has no reasons to believe that the "location" as claimed is relative to the vehicle location. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the vehicle location) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2172

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosain T Alam whose telephone number is (703) 308-6662. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 3800.



Hosain T. Alam
Primary Examiner
Art Unit 2172

August 15, 2001